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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kristian Knak NYGAARD, et al

Application No.: 10/556,936

Group No.: 2425

Filed: July 19, 2006

Examiner: - -

For: SYSTEM FOR TRANSMITTING INFORMATION FROM A STREAMED PROGRAM
TO EXTERNAL DEVICES AND MEDIA

Attorney Docket No.: U 016025-8

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

We draw the attention of the Examiner to the attached non-English Action or International-type Search Report from a foreign office in respect of counterpart Israeli Application No. 171984 and an English-language version thereof indicating the degree of relevance found by the foreign office. The English version of the Action or Search Report makes consideration of any non-English art required. MPEP 609.

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CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

*(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)*

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

☒ deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. 1.8(a)

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TRANSMISSION

☐ transmitted by facsimile to the Patent and Trademark Office. to (571)-273-8300

37 C.F.R. 1.10*

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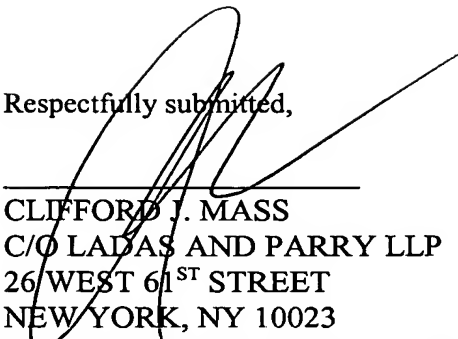
Date: June 3, 2009

Signature
CLIFFORD J. MASS
(type or print name of person certifying)

***WARNING:** Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).
"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

Form PTO-1449 is also attached with reference copies.

Respectfully submitted,



CLIFFORD J. MASS
C/O LADAS AND PARRY LLP
26 WEST 61ST STREET
NEW YORK, NY 10023
REG. NO. 39,086; (212) 708-1890



Practitioner's Docket No. U 016025-8

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Kristian Knak NYGAARD, et al**

Serial No.: 10/556,936

Group No.: 2425

Filed: July 19, 2006

Examiner: Ryan S. Stronczer

For: **SYSTEM FOR TRANSMITTING INFORMATION FROM A STREAMED PROGRAM
TO EXTERNAL DEVICES AND MEDIA**

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

ATTENTION: GROUP DIRECTOR

**TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT AFTER
MAILING DATE OF FINAL ACTION OR NOTICE OF ALLOWANCE
BUT BEFORE PAYMENT OF ISSUE FEE (37 C.F.R. 1.97(d))**

NOTE: 37 C.F.R. 1.97: "(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section [i.e., after the mailing date of any final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application], provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

(1) *The statement specified in paragraph (e) of this section; and*

(2) *The fee set forth in § 1.17(p)."*

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

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Mailing Label No. _____ (mandatory)

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Trademark Office. to (571)-273-8300

☐ **EFS-WEB**
transmitted electronically

Date: June 3, 2009

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

* *Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.*

NOTE: *If the information disclosure statement that contains the items required by 37 C.F.R. 1.97(d) is filed before, or simultaneously with, the payment of the issue fee, then it will be considered. See Notice of April 20, 1992 (1138 O.G. 37-41, 40) and 37 C.F.R. 1.97(d).*

TIME OF TRANSMITTAL OF ACCOMPANYING INFORMATION DISCLOSURE STATEMENT

1. The information disclosure statement transmitted herewith is being filed *after* a final action under § 1.113, or a notice of allowance under § 1.311, whichever occurs first, but before, or simultaneously with, the payment of the issue fee.

WARNING: *"A petition for suspension of action to allow applicant time to submit an information disclosure statement will be denied as failing to present good and sufficient reasons, since 37 C.F.R. 1.97 provides adequate recourse for the timely submission of prior art for consideration by the examiner." Notice of July 6, 1992 (1141 O.G. 63). But see § 103(b) and (c), limited suspension of action in a continued prosecution application (CPA) filed under § 1.53(d) and in a request for continued examination (RCE) under § 1.114.*

STATEMENT, PETITION AND FEE

2. In accordance with the requirements of 37 C.F.R. 1.97(d):
 - A. Accompanying this transmittal is a statement, as specified in 37 C.F.R. 1.97(e).
 - B. Applicant hereby petitions for the consideration of the accompanying information disclosure statement. 37 C.F.R. 1.97(d)(2).
 - C. Applicant submits the petition fee set forth in § 1.17(p) (\$180.00).

NOTE: *"The petition should be directed to the Group Director of the examining group handling the application. The petition need do nothing more than request consideration of the information being submitted." Notice of April 20, 1992 (1138 O.G. 37-41, 40).*

FEE DUE

3. Petition fee due (§ 1.17(p)): \$180.00

METHOD OF PAYMENT OF FEE

4.
 - ☒ Attached is a check for \$180.00.
 - ☐ Charge Account 12-0425 \$180.00.A duplicate of this petition is attached.

If any additional petition fees are due, please charge Account 12-0425.

Reg. No.: 30,086

Tel. No.: (212) 708-1890

Customer No.:



00140

PATENT TRADEMARK OFFICE

SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS

(type or print name of practitioner)

P.O. Address

c/o Ladas & Parry LLP
26 West 61st Street
New York, N.Y. 10023



Petitioner's Docket No. U 016025-8

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kristian Knak NYGAARD, et al

Application No.: 10/556,936

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STATEMENT FOR INFORMATION DISCLOSURE UNDER 37 C.F.R. SECTION 1.97(e)

NOTE: *A statement must state either: "(1) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement." 37 C.F.R. Section 1.97(e).*

Under the first statement under § 1.97(e), it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report. The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. See § 609B(5), M.P. E. P., 8th Edition.

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

*(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)*

I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. 1.8(a)

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EFS-WEB

☐ transmitted electronically

Date: June 3, 2009

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

** Only the date filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continue to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.*

NOTE: "Section 1.97(e) makes it clear that a certification could contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a search report from a patent office outside the U.S. not more than three months prior to the filing date of the statement. Under this certification, it would not matter whether any individual with a duty actually knew about any of the information cited before receiving the search report. In the alternative, the certification could state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual having a duty to disclose more than three months prior to the filing of the statement." Notice of January 9, 1992, 1135 O.G. 13-25, at 13. (emphasis added). Thus: "If an item of information is submitted within three months of being cited in a communication from a foreign patent office in a counterpart foreign application, the certification can be properly made regardless of any individual's previous knowledge of the information." *Id.*, 1135 O.G. at 19. See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. If the communication contains two dates, the mailing date of the communication is the one which begins the 3-month period. The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner. Likewise, the statement will be considered to have been filed on the date the statement was received in the Office, or on an earlier date of mailing or transmission if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 C.F.R. 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 C.F.R. 1.10." See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Thus,, for example, the certification of § 1.97(e) does not preclude the use of the certification in an application by corporations whose practitioners have over the years reviewed thousands of patents and technical publications even though they are unaware of the relevance of any one thereof to the application. Notice of January 9, 1992, 1135 O.G. 13-15, at 19.

See § 609B(5), M.P.E.P., 8th Edition:

"If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement."

NOTE: A copy of the foreign search report need not be submitted with the certification. Notice of April 20, 1992 (1138 O.G. 37-41, 40).

NOTE: "The phrase 'after making reasonable inquiry' makes it clear that the individual making the certification has a duty to make reasonable inquiry regarding the facts that are being certified. The certification can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a certification under 37 C.F.R. 1.97(e)(2) to the Office until a satisfactory response is received. The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "Although it is recognized that an individual actually becomes aware of the information in the communication from a foreign patent office sometime after it was mailed, the mailing date of such a communication, if it occurs prior to a first awareness of the same information, would determine the date for filing of an information disclosure statement without a fee" in a certification procedure under Section 1.97(e). Notice of January 9, 1992, 1135 O.G. 13-25, at 19 (emphasis added).

NOTE: The mere absence of an item of information for a foreign patent office communication is not intended to represent an opportunity to delay the submission of a item known more than three months prior to the filing of an information disclosure statement to an individual having the duty of disclosure under Section 1.56. 62 Fed. Reg. 53,131, 53,150 (Oct. 10, 1997).

NOTE: *The IDS is considered filed as of the date it is received in the PTO, or on an earlier date of mailing of transmission if done so with a properly executed certificate of mailing or facsimile transmission under 37 C. F.R. § 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 C.F.R. § 1.10. See § 609B(5), M.P.E.P., 8th Edition.*

NOTE: *"The certification under Section 1.97(e) should be made by a person who has knowledge of the facts being certified. The certification can be made by a practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry." Notice of January 9, 1992, 1135 O.G. 13-25 at 19.*

NOTE: *"The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application)." Notice of April 20, 1992 (1138 O.G. 37-41, 39).*

NOTE: *"Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent or inventor." 37 C.F.R. Section 1.56(d) and*

"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) each inventor named in the application;

(2) each attorney or agent who prepares or prosecutes the application; and

(3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. Section 1.56(c).

IDENTIFICATION OF INFORMATION DISCLOSURE STATEMENT FOR WHICH THIS STATEMENT IS BEING MADE

1. This statement is being made for the Information Disclosure Statement

☒ [X] accompanying this statement.

☐ [] filed _____.

Date

STATEMENT

2. I, the person(s) signing below state:

that each item of information contained in the information disclosure statement was **first** cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(1).

NOTE: *The three month period starts from the mailing date of the foreign patent office communication. Notice of January 9, 1992, 1135 O.G. 13-25 at 19. The mailing date is the "date on the communication by the foreign patent office." Notice of April 20, 1992 (1138 O.G. 37-41, 39).*

OR

that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(2).

NOTE: "The time at which information 'was known to any individual designated in 37 C.F.R. 1.56(c)' is the time when the information was discovered in association with the application even if awareness of the materiality came later." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

IDENTIFICATION OF PERSON(S) MAKING THIS STATEMENT

3. The person making this statement is

(check each applicable item)

(a) ☐ the inventor(s) who signs below

SIGNATURE OF INVENTOR

(type name of inventor who is signing)

(b) ☐ a person who is substantively involved in the preparation or prosecution of the application, and who is associated with the inventor, with the assignee, or with anyone to whom there is an obligation to assign the application (37 C.F.R. Section 1.56(c)) and who signs below.

SIGNATURE OF PERSON MAKING STATEMENT

(type name of person who is signing)

Address of person who is signing

(c) ☒ the practitioner who signs below on the basis of the information:

(check each applicable item)

- ☐ supplied by the inventor(s).
☒ supplied by an individual designated in Section 1.56(c).
☒ in the practitioner's file.

Reg. No.: 30,086

SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS

(type or print name of practitioner)

Tel. No.: (212) 708-1890

Customer No.:



00140

PATENT TRADEMARK OFFICE

P.O. Address

c/o Ladas & Parry LLP
26 West 61st Street
New York, N.Y. 10023

Date: 27 April 2009

10/556,936

Subject: Notice of Defects in Patent Application no. 171984

Reference: your memorandum of 9 December 2008

Notice: References to "the law" are to the Patent Law of 1967. References to the "regulations" are to the Patent Regulations (Patent Office administrative procedures, legal arrangements, forms and fees) of 1968. According to regulation 41, you are hereby informed that the above referenced application has the defects detailed below.

You must reply to this notice within four months of the date above, however, you may request an extension of the period [for reply]. If said request is submitted before the end of the period there is a 59 NIS fee for each month [of extension] or portion thereof.

These are the defects:

1. Independent claims 63, 73, 74 and 75 define an invention the nature of which is:

"Selecting at first location and identification at a second location section from a streamed broadcast based on time of selection."

Independent claims 67 and 76 define an invention the nature of which is:

"Preparing a streamed program using association of each discrete section with unique indication (UID)."

2. These are two separate inventions. Thus, the application does not comply with Section 8 of the law. Therefore, according to Section 24(B) of the law you are hereby requested to divide the application. Please note, that according to rule 51 of the Patents Law and the Registrar's Circular No. 62, the divided applications must be filed or a request for extension of their filing must be filed within four months of the mailing date of this letter.

3. In Publication No. WO02/091739 (PP. 34 and 35) a system including the following steps is described:

"Selecting and identifies broadcast channel 302, selecting a topic of interest 304 in a program. Determines and recording the universal time for enabling retrieving the selected topics."

4. Review of the aforesaid publication sets forth all the steps defined in the system claimed in the main claim of the present application.

Therefore the application does show inventive step as is required by Section 5 of the law.

Sincerely,

Paulette Ofir
Examiner